



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,998	06/17/2005	Jean-Marie Bernard	0076144-000004	1195

21839 7590 11/19/2009
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

CAMERON, ERMA C

ART UNIT	PAPER NUMBER
----------	--------------

1792

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

11/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/539,998	Applicant(s) BERNARD ET AL.	
	Examiner /Erma Cameron/	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10-14, 16-17, 19, 21-25, 28-33 and 35-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not contain a definition of a blocking group as defined in these claims, with the structure as drawn, and R2, R4 and R5 as defined. Although the specification discloses some aspects of the amended definition of a blocking group, such as at page 5, line 19 to page 6, line 21, the specification does not support the newly amended definition of blocking group as a whole.

The applicant is requested to cancel all new matter.

Art Unit: 1792

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The rejection of Claims 19, 27 and 30 under 35 U.S.C. 112, second paragraph, is withdrawn because of the amendment filed 7/6/2009.

5. Claims 13, 24, 25, 27 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 13, 24 and 32 define R2 as C1-C5, whereas the applicant has stated in the 7/6/2009 amendment (page 16) that R2 is defined in claims 13, 24 and 32 as being C2-C5.

b) Claim 27: there is no antecedent basis for “said five-membered nitrogenous heterocycles”.

c) Claim 25: is dependent on claim 21, and therefore the definitions of the R groups should not be based on claim 10.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1792

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62 - 164049.

'049 teaches making a coating with HMDI, 2-(m)ethylimidazole as blocking group, and a polyol. There may be other imidazoles as blocking agent, as well as other species of blocking agent. It appears that a combination of some of the imidazole blocking agents would result in the limitation of claim 14. The coating is dried at 70 C after application. The drying time is not given, but it would have been obvious to optimize the drying time thru no more than routine experimentation. See Abstracts and pages 5, 7 and Examples of translation.

8. Claims 10-11, 13-22, 24-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flosbach et al (6013326).

'326 teaches a coating composition that comprises a hydroxy resin, and an isocyanate such as HMDI that may be blocked with 2-methylimidazole or other conventional blocking agents, and which is dried at 80-160 C for 20-40 minutes. The limitation of at least 3.5 C of claims 14, 25 and 33 is met because the imidazole has 3 C and the methyl substituent has 1 C (see Abstract; 4:33-5:49; 7:45-8:18).

Art Unit: 1792

10. Claims 10-11, 13-22, 24-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nasar et al, Polymer International, 48, pp 614-620, 1999.

Nasar teaches reacting HMDI with 2-methylimidazole or benzimidazole to block the isocyanate group, followed by reaction with a polyol (see especially pages 615 and 620).

The limitation of at least 3.5 C of claims 14, 25 and 33 is met because the imidazole has 3 C and the methyl substituent has 1 C.

Response to Arguments

11. Applicant's arguments filed 7/6/2009 have been fully considered but they are not persuasive.

The applicant has argued for all the prior art rejections that the prior art does not disclose two-component systems that they contend is their claimed invention. However, according to the definition they have supplied on page 19 of the 7/6/2009 amendment, a two-component system is one in which a polyol and a polyisocyanate are reacted. It appears that the system that the applicant is claiming is not this two-component system as described on page 19, but rather a one-component system of a polyol and a blocked polyisocyanate (#3). The two-component system as defined at page 19 does not include a blocked isocyanate. Moreover, "two-component" system would not preclude the presence of a third component, as long as 2 components are present.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1792

November 16, 2009